

Application No.: 09/994,526  
Amendment Dated August 8, 2003  
Reply to Office Action dated April 9, 2003

## REMARKS

Claims 1-7 are pending in the application. In the Office Action it is noted that claims 1-4 are rejected under 35 U.S.C. § 102(b), and claims 5 and 6 are rejected under 35 U.S.C. § 103(a). Claim 7 has been withdrawn from consideration.

### Drawings

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available. Also, a Request for Approval of Proposed Drawing Change was submitted on November 27, 2001. Applicants respectfully request approval of the change.

### Claim Amendments

Claim 3 has been amended to correct a clerical error.

Claims 8-14 have been added to provide a more adequate basis for protection of the invention.

### Rejection under 35 U.S.C. § 102(b)

Claims 1-4 presently stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,082,077 to Holka ("Holka").

Each of claims 1-4 is directed towards a rack shaft having two rack teeth groups "longitudinally apart from each other." Holka, on the other hand, discloses a rack shaft (32) having two rack teeth groups (116, 118) that longitudinally overlap as shown in Holka Fig. 9. That is, Holka fails to disclose the rack teeth groups being "longitudinally spaced apart." Therefore, Holka cannot anticipate any of claims 1-4.

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In addition, each of claims 1-4 is directed towards a hollow rack shaft. Thus, in order for Holka to anticipate these claims, Holka must disclose a hollow rack shaft. However, while Holka does disclose a steering gear assembly comprising a rack shaft, Holka is silent with regard to the rack shaft being hollow. Therefore, since Holka fails to disclose a hollow rack shaft, Holka cannot anticipate any of claims 1-4.

Accordingly, it is respectfully requested that the rejection of claims 1-4 under 35 U.S.C. § 102(b) over Holka be reconsidered and withdrawn.

**Rejection under 35 U.S.C. § 103(a)**

Claims 5 and 6 presently stand rejected under 35 U.S.C. § 103(a) over Holka in view of U.S. Patent No. 4,741,191 to Anderson et al. ("Anderson").

Claims 5 and 6 are directed towards a hollow rack shaft. As pointed out above, Holka fails to disclose two rack teeth groups longitudinally spaced apart, and Holka is silent with regard to a hollow rack shaft. Anderson is directed towards a manufacturing method for manufacturing parts for an automatic transmission, such as a clutch hub. As such, Anderson is silent with regard to longitudinally spaced rack teeth groups and with regard to a hollow rack shaft as well. Therefore the proposed combination of Holka and Anderson would fail to suggest longitudinally spaced rack teeth groups, and also would be silent with regard to a hollow rack shaft.

In addition, Anderson is not properly combinable with Holka for at least two reasons. First, there is no suggestion in Holka or Anderson for the combination set forth in the Office Action where the teeth of Holka can be formed with a die as taught by Anderson, particularly because the method employed by Anderson does not form a shaft having teeth resembling that of Holka, and there is no apparent modification suggested in the references for forming such a rack shaft. Second, Holka and Anderson are considered to be nonanalogous to each other, Holka being directed towards a steering gear assembly

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and Anderson being directed towards a method of manufacturing a clutch hub for an automatic transmission.

Finally, the Examiner stated that Anderson teaches forming rack teeth by die forming. This understanding is basically incorrect. Anderson discloses manufacturing method of clutch hub but not manufacturing (forming) method of rack teeth. Clutch hub has no rack teeth. The numerals 26 and 30 denote the lower and upper dies respectively and the numeral 42 denotes clutch hub blank (workpiece) as described in column 3, line 63 to column 4, line 6 of Anderson. Therefore, Anderson fails to disclose forming rack teeth by die forming.

Thus, for all of the reasons discussed above, the proposed combination of Holka and Anderson cannot render claims 5 and 6 obvious.

Accordingly, it is respectfully requested that the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) over Holka in view of Anderson be reconsidered and withdrawn.

### **New Claims**

Claims 8-14 have been added to provide a more adequate basis for protection of the invention. New claims 8 and 12 each recite a hollow rack shaft, and therefore each of claims 8 and 12, as well as claims 9-11, 13 and 14 which depend from claims 8 and 12, respectively, patentably distinguishes over the cited art for at least the same reasons discussed above.

### **CONCLUSION**

In view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

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This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. §1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any fee required for such Petition for Extension of Time, and any other fee required by this document, other than the issue fee, and not submitted herewith, should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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